RESPONSE AND REMARKS

This is in response to the Office Action regarding the above-identified application dated October 21, 2005.

Amendments to Claims 7, 10-13, 23 and 26 are filed concurrently herewith to more distinctly claim the claimed invention. Claims 14 and 24-25 remain in the application as previously presented. Original Claims 1-6, 8, 9, and 15-22 were previously withdrawn without prejudice. Entry of the amendments, and reconsideration of the application, as amended, are respectfully requested in view of the following remarks.

AMENDMENTS TO THE SPECIFICATION

Amendments to the Specification are submitted herewith to delete the section title "FIELD OF THE INVENTION" immediately following the title of the application, and paragraph [0001] of the application as filed so that the "CROSS REFERENCE TO RELATED APPLICATIONS" section is the first section in the application in accordance with 37 C.F.R. §1.78; because the Claim of Priority was submitted in the Declaration filed with the application and with the transmittal letter filed with the present application, and because the Claim of Priority was recognized in the official Filing Receipt for the present application, then according to MPEP § 201.11 III.D, no petition or surcharge is due.

CLAIM OBJECTIONS UNDER 35 U.S.C. § 132 (a)

In the Office Action, earlier-filed amendments were objected to under 35 U.S.C. § 132 (a) as introducing new matter not supported by the original specification. Specifically, the following limitation was objected to:

...the first user is designated in a memory accessible by the computer system as restricted from finalizing shipping labels.

The Office Action stated that "the specification talks about users being able to finalize shipping labels, but not specifically disclose the system designating users

as being 'restricted from finalizing the shipping labels' does not appear in the specification...". The Office Action concluded that the specification does not support the objected to limitation and stated that "[a]pplicant is required to cancel the new matter in reply to this Office Action." The Office Action did not identify the specific Claims objected to under Section 132(a); the Office Action later rejected Claims 7, 11, 13 and 14 under 35 U.S.C. § 112, first paragraph, on similar grounds "as failing to comply with the written description requirement."

The objections under 35 U.S.C. §§ 112 and 132 have been carefully considered. It is respectfully submitted, for the reasons given below, that the previously-filed amendments did not add any new matter and that the "restricted from finalizing shipping labels" limitation is fully supported by the specification as required under the first paragraph of 35 U.S.C. § 112 and does not introduce new matter as prohibited under 35 U.S.C. § 132 (a).

The "Restricted From Finalizing Shipping Labels" Limitation

It is respectfully submitted that the only claim in which the specific objected-to "restricted from finalizing shipping labels" limitation appears, is Claim 7. However, Claim 10 (as it was originally filed and also as it was previously amended) provided a similar limitation. As originally filed, Claim 10 recited: "... designate a particular user within an enterprise as restricted from printing shipping labels according to instructions input by an administrator of the enterprise." As currently amended, Claim 10 recites: "... designate in a memory accessible by the computer system, a first set of shipping privilege settings identifying each user of a plurality of users within the enterprise as restricted from printing shipping labels but authorized to submit pre-processing shipping requests ...".

First, because the recitation "... designate a particular user within an enterprise as restricted from printing shipping labels according to instructions input by an administrator of the enterprise ..." was provided by an original claim, namely Claim 10, that recitation was part of the specification, and therefore satisfies the written description requirement under section 112. *See Union Oil*

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<u>Co. of California v. Atlantic Richfield Co.</u>, 208 F.3d 989, 998, n.4, (Fed. Cir. 2000), *cert. denied*, 121 S. Ct. 1167 (2001) ("One of this court's predecessor courts clarified that disclosure in an originally filed claim satisfies the written description requirement. *See* <u>In re Gardner</u>, 480 F.2d 879, 880, 178 U.S.P.Q. (BNA) 149 (CCPA 1973) ("Under these circumstances, we consider the original claim in itself adequate 'written description' of the claimed invention. It was equally a 'written description' ... whether located among the original claims or in the descriptive part of the specification.").").

It is respectfully submitted that the recitation "... designate a particular user within an enterprise as *restricted from printing shipping labels* according to instructions input by an administrator of the enterprise", provided by an original claim, namely Claim 10, is support by the specification as required under the first paragraph of 35 U.S.C. § 112 for one form of "restricted from finalizing shipping labels" in that printing a shipping label is one form of finalizing a shipping label.

It is therefore respectfully submitted that, because the recitation "... designate a particular user within an enterprise as restricted from printing shipping labels according to instructions input by an administrator of the enterprise ..." was provided by an original claim, and because that original claim language supports the objected-to limitation, the claims as amended do not introduce new matter.

Further, it is respectfully submitted that that the below-cited references to the specification, for example, when read together, support the objected-to "restricted from finalizing shipping labels" limitation:

> 1.) "Administrator-established privileges [on a System database 52 (*see, e.g.,* Published Application (US 2002/0032573 A1), Specification, paragraphs 0116 -0118)] for each particular User controls the functionality available to the particular User.... The System provides the administrator the ability to assign User privileges such as: ... Ability to print shipping labels vs. traveler labels, by Carrier or by service..." (Published Application (US 2002/0032573 A1), Specification, paragraphs 0130 - 0134);

2.) "For shipping circumstances in which a User is not allowed to print an actual shipping label, Users can print "traveler" labels, which help identify pre-processed packages for mailroom personnel to complete." (Published Application (US 2002/0032573 A1), Specification, paragraph 0413);

3.) "In one exemplary embodiment of the invention, the Desktop User is either not authorized by the Administrator to print Shipping Labels, or is limited by the Administrator to printing Shipping Labels for only certain types of packages, e.g., Letters. In such an embodiment, the Administrator enables a Shipping Station for the Desktop User. In some cases, a particular Desktop User may decide to not finalize shipping and delegate the actual shipping to some other user within the Enterprise. For example, if the Desktop User is not certain of the weight of a package, the Desktop User, even if that user has shipping lab[el] printing privileges, may decide to print a traveler label, attach the traveler label to the package, and forward the package to a Shipping Station User to complete shipping." (Published Application (US 2002/0032573 A1), Specification, paragraph 0447).

4.) Referring to FIG. 55, the specification explains that "[t]he User enters package and shipping information 335 which is stored in the System databases 336. The User requests printing of a traveler label, which the System prints on a printer local to the User 340. The User delivers the package together with the traveler label to the Shipping Station. The Shipping Station then scans in the Traveler Label 341 in order to retrieve the package and shipping information from the System's databases 342-344 to populate the shipping information necessary to rate the shipment and finalize the shipping process and complete a shipping label 345-351. This application is used, for example, where Desktop Users have no way of weighing each package." (Published Application (US 2002/0032573 A1), Specification, paragraph 0448);

5.) Referring to FIG. 56 (which depicts an exemplary traveler label), the specification further explains that "[a]s was described above in relation to 345-351 depicted in FIG. 55, the System uses the retrieved package and shipping information, e.g., 363 and 364, to populate the shipping information necessary to rate the shipment and finalize the shipping process and complete a shipping label." (Published Application (US 2002/0032573 A1), Specification, paragraph 0449).

It is respectfully submitted that, *e.g.*, the citation to the Specification in 3.) above that " the Desktop User is either not authorized by the Administrator to print Shipping Labels ..." supports the objected-to "restricted from finalizing

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shipping labels" limitation in that printing shipping labels is one form of finalizing shipping labels.

Further, it is respectfully submitted that, *e.g.*, the citation to the Specification in 4.) above that after "[t]he User requests printing of a traveler label ...", "[t]he Shipping Station then scans in the Traveler Label ... in order to retrieve the package and shipping information from the System's databases ... to populate the shipping information necessary to rate the shipment and finalize the shipping process and complete a shipping label ..." supports the objected-to "restricted from finalizing shipping labels" limitation in that the user described as requesting printing of a Traveler Label did not finalize the corresponding shipping label; the corresponding shipping label was finalized via the described Shipping Station.

The subject matter of a claim need not be described in exactly the same terms in the specification in order for the specification to satisfy the description requirement. *See e.g.*, MPEP §2163.02 ("The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement");*See also, e.g., University of Rochester v. G.D. Searle & Co., Inc.*, 358 F.3d 916, 922-23 (Fed. Cir. 2004), *reh'g en banc denied*, 375 F.3d 1303 (Fed. Cir. 2004), *cert. denied*, 125 S. Ct. 629 (2004) (``...this court and its predecessor have repeatedly held that claimed subject matter `need not be described in haec verba' in the specification to satisfy the written description requirement, *e.g., In re Smith,* 481 F.2d 910, 914 (CCPA 1973) ...").

It is respectfully submitted that, because the above-cited references in the Specification, read together, fully support the objected-to "restricted from finalizing shipping labels" limitation, the claims as previously amended, and as currently amended, do not introduce new matter. It is therefore respectfully requested that the objection under 35 U.S.C. § 132 (a) be reconsidered and withdrawn. In the event that the objection under 35 U.S.C. § 132 (a) is not withdrawn, it is respectfully requested that the specific Claim or Claims objected to under Section 132(a) be identified.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112

In the Final Office Action, Claims 7, 11, 13 and 14 were rejected under 35 U.S.C. § 112, first paragraph, "as failing to comply with the written description requirement." The Examiner referred to the above-outlined "objection to amendment" as grounds for the Section 112 rejection, saying that "[t]he claims(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention."

For the reasons described above with respect to the objection under Section 132(a), it is respectfully submitted that the specification supports the objected-to "restricted from finalizing shipping labels" limitation, that the previously-filed and currently -filed amendments do not add new matter, and that, therefore, the claims comply with the written description requirement under Section 112, first paragraph.

Further, it is respectfully submitted that none of Claims 10-14 contain the objected-to "restricted from finalizing shipping labels" limitation.

For the reasons previously given above, it is therefore respectfully requested that the rejection of Claims 7, 11, 13 and 14 under 35 U.S.C. § 112, first paragraph, be reconsidered. In the event that the rejection under 35 U.S.C. § 112, first paragraph has not been resolved in view of the above-given reasons, then in view of the fact that none of Claims 10-14 contain the objected-to "restricted from finalizing shipping labels" limitation, it is respectfully requested that the specific Claim or Claims rejected under Section 112, first paragraph be identified.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected Claims 7, 10-14 and 23-26 under 35 U.S.C. §103(a) as unpatentable over Gendreau (U.S. Publication No. US 2001/0034608; "*Gendreau*") in view of Stefik et al., (US Publication No. US 2003/0115144; "*Stefik*").

<u>REMARKS REGARDING THE SECTION 103(a) REJECTION</u>

The Examiner's rejections under Section 103(a) have been carefully considered. Claims 7, 10-13 and 23 have been amended to more distinctly recite the claimed invention. For the reasons given below, it is respectfully asserted that neither <u>Gendreau</u> nor <u>Stefik</u>, whether considered alone or in combination with any other reference of record, anticipate, disclose, teach or suggest all of the limitations of amended independent Claims 7 and 10, or the claims dependent on them.

Independent Claim 7

Amended independent Claim 7 is directed to an online, Internet-based, multi-carrier, multi-parcel shipping management computer system that is programmed to:

receive a request by a first user within an enterprise to ship a parcel, wherein the first user is designated in a memory accessible by the computer system as restricted from finalizing shipping labels, wherein the request comprises a set of partial shipment information, and wherein the set of partial shipment information comprises at least one of: a destination name, a destination address, a return name, a return address, or package information;

in response to the request by the first user to ship the parcel: (A) generate a printable bar-coded pre-processing traveler label, wherein the printable bar-coded pre-processing traveler label comprises at least a machine-readable code that corresponds to the request, (B) save in the memory accessible by the computer system, a relationship between the machine-readable code and the set of partial shipment information, and (C) print the printable bar-coded pre-processing traveler label, wherein said printed printable bar-coded pre-processing traveler label comprises an expression of the machine-readable code;

receive an input for finalizing a shipping label for shipping the parcel from a second user within the enterprise, wherein the second user is designated in the memory accessible by the computer system as authorized to finalize shipping labels, wherein said input comprises the machine-readable code;

retrieve from the memory the set of partial shipment information according to the machine-readable code; and

generate a shipping label comprising at least a first item of information from the set of partial shipment information and according to the input from the second user.

It is respectfully asserted that the prior art references of record do not anticipate, disclose, teach or suggest all of the limitations of amended independent Claim 7. For example, it is respectfully asserted that the prior art references of record, even when combined, do not anticipate, disclose, teach or suggest the limitations recited in amended Claim 7 that the claimed system will "... generate a printable bar-coded pre-processing traveler label ... compris[ing] ... a machine-readable code ..." and will save in a memory "... a relationship between the machine-readable code and the set of partial shipment information ..." for a request to ship a parcel.

As compared to generating a machine-readable code as recited in Claim 7 and saving a relationship between the machine-readable code and information related to a shipping request, *Gendreau* discloses a label containing "... computer-readable information relating to at least one of a destination, level of service (e.g., delivery date), and delivery mode of the parcel ..." and further discloses "... input[ting] the computer-readable information into the computer system 18 ...". *Gendreau*, paragraph [0032]. That is, as compared to the subject matter of Claim 7 wherein the machine readable code is generated and saved by the claimed system, the information in *Gendreau* pre-exists, *e.g.*, was created as the box is manufactured or when an order is packaged in the box (*see, e.g., Gendreau*, paragraph 0032) and must be "input" into the *Gendreau* system.

Further, as compared to "...sav[ing] in the memory accessible by the computer system, a relationship between the machine-readable code and the set of partial shipment information ..." as recited in, e.g., Claim 7, *Gendreau* discloses that "... an input device 20, such as a bar code scanner, is used to read the computer-readable information relating to at least one of a destination, level of service (e.g., delivery date), and delivery mode of the parcel and to input the computer-readable information into the computer system 18...." *Gendreau*, paragraph [0032]. That is, as compared to the subject matter of, e.g., Claim 7, wherein a relationship between a machine-readable code and shipment

information is saved, *Gendreau* discloses reading the shipment information from an invoice.

In view of the above-given reasons that the prior art references of record do not anticipate, disclose, teach or suggest all of the limitations of amended independent Claim 7, it is respectfully asserted that the prior art references of record do not teach or suggest all of the limitations of Claims 23-25, that are, in one way or another, dependent on Claim 7.

Further, for reasons similar to those described above with respect to amended Claim 7, it is respectfully asserted that the prior art references of record do not anticipate, disclose, teach or suggest all of the limitations of amended dependent Claim 11, which, as amended, more distinctly recites that the claimed system will "... generate a printable bar-coded pre-processing traveler label ... compris[ing] ... a machine-readable code ..." and will save in a memory "... a relationship between the machine-readable code and the particular request to ship the particular package ...".

Independent Claim 10

Amended independent Claim 10 is directed to an online, Internet-based, multi-carrier, multi-parcel shipping management computer system that is programmed to:

> according to a first set of instructions input by an administrator of an enterprise, designate in a memory accessible by the computer system, a first set of shipping privilege settings identifying each user of a plurality of users within the enterprise as restricted from printing shipping labels but authorized to submit pre-processing shipping requests;
> according to a second set of instructions input by the administrator, designate in the memory, a second set of shipping privilege settings identifying at least a second user within the enterprise as authorized to print shipping labels according to a pre-processing shipping request by any user of the plurality of users; and
> in response to an input by a first user of the plurality of users, display interactive graphic user interface shipping selection options to the first user according to the first set of shipping privilege settings.

It is respectfully asserted that the prior art references of record do not anticipate, disclose, teach or suggest all of the limitations of amended

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independent Claim 10. For example, it is respectfully asserted that the prior art references of record, even when combined, do not anticipate, disclose, teach or suggest the limitations recited in amended Claim 10 that the claimed system is programmed to "... in response to an input by a first user of the plurality of users, display interactive graphic user interface shipping selection options to the first user according to the first set of shipping privilege settings."

As compared to the "usage rights" of *Stefik* that are permanently "attached" to a digital work (*see, e.g., Stefik*, paragraph 0041), amended Claim 10 recites that, "... in response to an input by a first user of the plurality of users, display interactive graphic user interface shipping selection options to the first user according to the first set of shipping privilege settings...."

In view of the above-given reasons that the prior art references cited by the Examiner do not teach or suggest all of the limitations of amended independent Claim 10, it is respectfully asserted that the prior art references cited by the Examiner do not teach or suggest all of the limitations of Claims 11-14, and Claim 26, that are, in one way or another, dependent on Claim 10.

CONCLUSION

In view of the foregoing amendments, and for the foregoing reasons and authorities, it is respectfully submitted that the invention disclosed and claimed in the present amended application is not fairly taught by any of the references of record, taken either alone or in combination, and that the application is in condition for allowance. Accordingly, reconsideration and allowance of the amended application is respectfully requested.

Respectfully submitted,

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